

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 4-13 and 15-24 are pending in the present application. Claims 1, 2, 12 and 13 are amended, Claims 3 and 14 are cancelled and Claims 23 and 24 are added by the present response.

Support for amendments and additions to the claims can be found, at least, in the claims as originally filed, page 14, lines 20-24 and 29-32 and page 15 lines 1-3, 17-21 and 26-34. Thus, no new matter is added.

In the outstanding Office Action, Claims 1, 5, 6, 10-12, 16, 17, 21 and 22 were rejected under 35 U.S.C. §102(e) as anticipated by Ellis et al (U.S. Pat. No. 2003/0149988, herein Ellis); Claims 2-4, 7, 8, 13-15, 18 and 19 were rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of Scarampi (U.S. Pat. No. 4,931,865); and Claims 9 and 20 were rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of Applicants' Admitted Prior Art (AAPA).

Independent Claims 1 and 12 have been amended to include the features of dependent Claims 2 and 3 and Claims 13 and 14, respectively. Accordingly, Applicants respectfully submit that rejection of Claims 1 and 12 under 35 U.S.C. §102(e) as anticipated by Ellis is moot as pages 4 and 5 of the outstanding Office Action acknowledge that Ellis does not teach the features of Claims 2, 3, 13 and 14.

With respect to the rejection of Claims 2-4, 7, 8, 13-15, 18 and 19 under 35 U.S.C. §103(a) as unpatentable over Ellis and Scarampi, Applicants respectfully traverse this rejection.

Amended Claim 1 recites, in part,

A system for distributing picture objects comprising a communications network, at least one media center connected

to this communications network, a user interests database connected to the media center, in which user interests database user interests profiles are stored, a picture object database connected to the media center, in which picture object database the picture objects and picture object information assigned to these picture objects are stored, and one or more communications terminals connectible to this communications network which each have a display unit by means of which display unit the picture objects are made visible to a user of one of the communications terminals, wherein

...the communications terminals each comprise a direction-of-view-determining module for determining the current direction of view of at least one eye of the user;

the media center further comprises a direction-of-view-evaluation module, which, on the basis of the current direct of view that is transmitted in each case by the respective communications terminal over the communication network to the media center, and on the basis of video objects and/or picture objects transmitted from the media center over the communications network to the respective communications terminal, determines picture objects being viewed by the user of the respective communications terminal; and

the media center further comprises an interests-determining module which, on the basis of the picture objects selected through the direction-of-view-evaluation module, determines user interest profiles and stores then in the user interests database.

Claim 12 recites similar features.

Ellis describes a program guide system that allows users to direct a server to record certain programs that later may be played back to the user on demand.¹ Further Ellis describes user specific directories of pointers to programs that have been recorded for the user.² According to Ellis, a media server retrieves the recorded program upon a playback request from the user, the playback request including a user identifier and a pointer to the user directory.³

¹ Ellis, paragraph [0011].

² Ellis, paragraph [0082].

³ Ellis, paragraph [0157].

Nonetheless, Ellis does not describe or suggest monitoring the actual viewing of a program by a user or automatically generating user interest profiles without user input. Instead, as described above, in Ellis the user directory is based strictly on user requests.

The outstanding Action relies on Scarampi as curing the deficiencies of Ellis with regard to the claimed invention.

Scarampi describes detecting from light reflections in a viewer's eyes, whether or not a television screen is looked at by the viewer.⁴ Through clock time correlation, Scarampi determines which person and how many persons view a commercial or any particular segment of a broadcast on any particular television channel.⁵ According to Scarampi this information is used by broadcasters to determine the degree and level at which viewers actually view parts of broadcast programming.⁶

However, Scarampi does not describe or suggest determining specific picture objects (for example picture contents) viewed by the user, based on the current direction of view. In addition, Scarampi does not make any suggestion of user interests profiles. While Scarampi does teach how to assess the level at which broadcast programming is viewed by users, Scarampi does not make any reference to establishing the viewing preferences of a specific user.

With respect to the combination of Ellis and Scarampi, Page 5 of the outstanding Office Action states that "it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching Ellis with...the communications terminal taught by Scarampi...as an easier and more accurate way to monitor the actual viewing of the program."

⁴ Scarampi, col. 6, lines 61-65.

⁵ Scarampi, col. 5, lines 49-55.

⁶ Scarampi, col. 5, lines 55-61.

However, Ellis *makes no reference to any monitoring of user viewing habits* or automatically establishing user interests profiles based thereon. Consequently, one skilled in the art would have had no motivation to combine the teachings of Ellis with those of Scarampi.

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,⁷ and by "clear and particular" evidence⁸ of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Ellis by incorporating the teachings of Scarampi. Without such motivation and absent improper hindsight reconstruction,⁹ a person of ordinary skill in the art would not be motivated to perform the proposed modification, and the present claims are believed to be non-obvious and patentable over the applied prior art.

In addition, Ellis is not concerned with as an easier and more accurate way to monitor the actual viewing of the program. Instead, Ellis is concerned with a program guide system that allows users to direct a server to record certain programs that later may be played back to the user on demand and its structure already achieves this goal. Ellis does not suggest that further improvement is desired nor that another feature should be added to the system. In particular, Ellis does not suggest monitoring the actual viewing of the program, such as is disclosed in Scarampi.

⁷ In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on fact findings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

⁸ In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.") (emphasis added).

⁹ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

The Ellis and Scarampi references, therefore, do not provide the motivation to perform the proposed modification of Ellis. In other words, an attempt to bring in the isolated teaching of Scarampi into Ellis would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.¹⁰ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.¹¹ In this case, the record fails to support the proposed modification of Ellis.

Moreover, as neither Ellis nor Scarampi describes or suggests automatically establishing user interests profiles, even if Ellis and Scarampi are combined, Claims 1 and 12 still patentably distinguish over these references. Thus, neither Ellis nor Scarampi describe or suggest an interest-determining module which, on the basis of picture objects selected through direction-of-view-evaluation, determines user interest profiles and stores them in a user interests database.

Accordingly, Applicants respectfully submit the amended Claims 1 and 12 and claims depending therefrom patentably distinguish over the cited Ellis and Scarampi references considered individually or in combination.

In addition, with respect to newly added Claims 23 and 24, neither Ellis nor Scarampi teaches or suggests picture object information assigned to picture objects and comprising data concerning products and/or services in which the respective user is interested. Nor do the cited references describe a media center that uses the picture object information to determine user interest.

¹⁰ See In re Ehrreich 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

¹¹ In re Lee, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references...must be based on objective evidence of record...[The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

Accordingly, Claims 23 and 24 also patentably distinguish over the cited Ellis and Scarampi references considered individually or in combination.

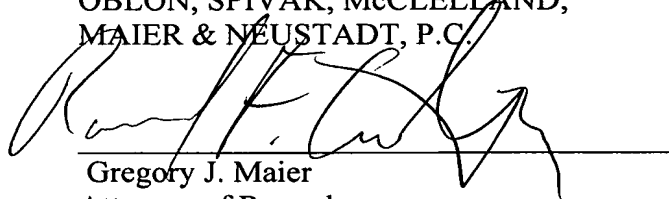
Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Should the Examiner have any further questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number

Additionally, Applicants respectfully request that reference "AW" found at the bottom of the IDS filed 2/20/02 and the references "AW" and "AX" found at the bottom of the IDS filed 1/30/2006 be acknowledged.

Respectfully submitted,

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